



United States Patent and Trademark Office

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Commissioner for Patents
United States Patent and Trademark Office
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Charles A. Muserlian
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New York, New York 10036-2646

Dear Mr. Muserlian:

This is in response to your letter received 07 February 2006 inquiring about the status of U.S. patent application 10/517,982 filed 13 December 2004. According to the USPTO electronic database, a petition under 37 CFR 1.47 was filed in the application on 09 June 2005 and a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant on 13 July 2005. Applicant's petition was dismissed in an Office decision of 23 February 2006. Copies of the decision and of the Notice are attached herewith for applicant's convenience.

Sincerely,

Nguyễn Ngọc-Hồ
Paralegal Specialist
PCT Legal Office

Tel: (571) 272-3290

Enclosure:

- Copy of decision
- Copy of Form PCT/DO/EO/905

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (3) and (4).

Regarding item (1), applicant has only provided payment of \$130.00 for the petition fee. Applicants are advised that pursuant to 37 CFR 1.17(g) the petition fee is \$200.00.

Regarding item (2) above, petitioner states that Eduardo Trifoni and Matteo Lenardon have refused to sign the application. Section 409.03(d) of the MPEP, **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that Eduardo Trifoni and Matteo Lenardon have refused to sign the application. A review of the present petition reveals that applicant has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and

oath/declaration to Eduardo Trifoni and Matteo Lenardon. The declaration of Annie Tuosto states that she mailed a copy of the application and an assignment document to Mr. Trifoni on 08 July 2004 and Mr. Lenardon on 09 September 2004. Both sets of papers were mailed prior to applicant entering the national stage in the United States and do not appear to have contained a declaration for the purposes of entering the national stage in the United States but merely an assignment document. As detailed above, the inventors must be presented with an oath or declaration for execution. As to Mr. Lenardon, his silence cannot be constituted as a refusal in the immediate circumstances as it is unclear whether he received the papers and whether they did in fact contain an oath or declaration for execution. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English.

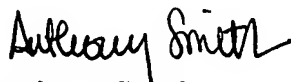
In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Applicant is advised that in order for the renewed petition to be considered applicant must provide payment of the remaining \$70.00. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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